REMARKS

Claims 1, 4, 5, 8-23 and 26-32 were pending prior to this Response. By the present communication, no claims have been amended, added or canceled. Accordingly, claims 1, 4, 5, 8-23 and 28-32 are currently pending in this application.

Rejection under 35 U.S.C. §102

Applicants respectfully traverse the rejection of claims 1, 4, 5, 8-17, 19-23, and 29-32 under 35 U.S.C. §102(a) as allegedly being anticipated by Parnot, *et al.* (hereinafter, "Parnot"). To anticipate, a single reference must inherently or expressly teach each and every element of claimed invention. *In re Spada*, 15 USPQ2d 1655 (Fed Cir. 1990); and *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). M.P.E.P. § 2131.

The Office action alleges that Parnot teaches a method of constructing a library of mutated angiotensin II type 1A receptors by *randomly* mutating the receptor to generate *every possible mutation*, on average five substitutions per residue, and expressing the library in mammalian cells (emphasis added). Applicants respectfully submit that the assays of Parnot relate to the regular function of the selected protein. In other words, Parnot discloses methods of finding every possible way to constitutively activate a receptor of known function (*i.e.*, angiotensin II type 1A).

Applicants submit herewith a declaration under 37 C.F.R. §1.131, by Philip A. Beachy and Jussi Taipale, co-inventors of the instant application, with Exhibit 1, which demonstrates that the claimed invention was made in the United States prior to the June 20, 2000 publication date of Parnot. Accordingly, Parnot is not available as prior art against the claimed invention. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §103

Applicants respectfully traverse the rejection of claim 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Parnot in view of King et al. (hereinafter "King"). The recent

U.S. Supreme Court decision in the KSR International v. Teleflex Inc. (82 USPQ2d 1385), modified the standard for establishing a prima facie case of obviousness. Under the KSR rule, three basic criteria are considered. First, some suggestion or motivation to modify a reference or to combine the teachings of multiple references still has to be shown. Second, the combination has to suggest a reasonable expectation of success. Third, the prior art reference or combination has to teach or suggest all of the recited claim limitations. Factors such as the general state of the art and common sense may be considered when determining the feasibility of modifying and/or combining references.

The Office Action alleges that Parnot teach a reporter construct which expresses a luminescent protein. The Office relies upon King as allegedly teaching constructing a heterologous reporter system by combining the *E.coli*-β-galactosidase gene (lacZ) under yeast pheromone responsive FUS1 promoter to study G protein coupled receptor activation. However, it is respectfully submitted that the primary reference, Parnot, is not available as prior art and thus, cannot properly be applied in a rejection under 35 U.S.C. § 103(a).

As set forth above, submitted herewith is a declaration under 37 C.F.R. §1.131, by Philip A. Beachy and Jussi Taipale, co-inventors of the instant application, with Exhibit 1, which demonstrates that the claimed invention was made in the United States prior to the June 20, 2000 publication date of Parnot. Accordingly, Parnot, is not available as prior art against the claimed invention.

Applicants respectfully submit that *prima facie* obviousness of the invention over the cited references, either alone or in combination, has not been established by the Examiner. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103 for alleged lack of patentability are respectfully requested.

Applicants respectfully traverse the rejection of claim 28 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Parnot in view of Lerner, et al. (hereinafter "Lerner"). The Office relies upon Lerner as allegedly disclosing a method of identifying antagonists or agonists for G-protein coupled receptors using a pigment cell. However, it is respectfully submitted that

the primary reference, Parnot, is not available as prior art and thus, cannot properly be applied in a rejection under 35 U.S.C. § 103(a).

As set forth above, submitted herewith is a declaration under 37 C.F.R. §1.131, by Philip A. Beachy and Jussi Taipale, co-inventors of the instant application, with Exhibit 1, which demonstrates that the claimed invention was made in the United States prior to the June 20, 2000 publication date of Parnot. Accordingly, Parnot is not available as prior art against the claimed invention. Reconsideration and withdrawal of this rejection are respectfully requested.

Applicants respectfully submit that *prima facie* obviousness of the invention over the cited references, either alone or in combination, has not been established by the Examiner. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103 for alleged lack of patentability are respectfully requested.

Conclusion

In summary, for the reasons set forth herein, Applicants submit that the claims clearly and patentably define the invention and respectfully request that the Examiner withdraw all rejections and pass the application to allowance. If the Examiner would like to discuss any of the issues raised in the Office Action, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

The Commissioner is hereby authorized to charge $405.00 as payment for the Request for Continued Examination fee to Deposit Account No. 07-1896. Additionally, the Commissioner is hereby authorized to charge any other fees that may be due in connection with the filing of this paper, or credit any overpayment to Deposit Account No. 07-1896, referencing the above-identified docket number.

Respectfully submitted,

Date: April 24, 2008

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Enclosure: Declaration under 37 C.F.R. § 1.131 (with Exhibit 1)